UNITED STATES PATENT AND TRADEMARK OFFICE

APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/982,644	10/18/2001	Yuichi Takatsu	65316-0007	8152

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EXAMINER
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ART UNIT	PAPER NUMBER
3692	

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Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

PTOL-90A (Rev. 04/07)

	Application No.	Applicant(s)
Office Action Summary	09/982,644	TAKATSU, YUICHI
	Examiner	**Art Unit**	
	HARISH T. DASS	3692	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE <u>3</u> MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.
- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

1)☒ Responsive to communication(s) filed on <u>16 March 2009</u>.
2a)☒ This action is **FINAL**.   2b)☐ This action is non-final.
3)☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

4)☒ Claim(s) <u>1-35</u> is/are pending in the application.
    4a) Of the above claim(s) <u>8-35</u> is/are withdrawn from consideration.
5)☐ Claim(s) _____ is/are allowed.
6)☒ Claim(s) <u>1-7</u> is/are rejected.
7)☐ Claim(s) _____ is/are objected to.
8)☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

9)☐ The specification is objected to by the Examiner.
10)☐ The drawing(s) filed on _____ is/are: a)☐ accepted or b)☐ objected to by the Examiner.
    Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
    Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
11)☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

12)☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
    a)☐ All   b)☐ Some * c)☐ None of:
      1.☐ Certified copies of the priority documents have been received.
      2.☐ Certified copies of the priority documents have been received in Application No. _____.
      3.☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
    * See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

1) ☐ Notice of References Cited (PTO-892)
2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
3) ☐ Information Disclosure Statement(s) (PTO/SB/08) Paper No(s)/Mail Date _____.

4) ☐ Interview Summary (PTO-413) Paper No(s)/Mail Date. _____ .
5) ☐ Notice of Informal Patent Application
6) ☐ Other: _____ .

DETAILED ACTION

1.   This communication is in response to applicant's communication filed on

3/16/2009.

2.   **Priority Claimed:** 10/18/2000

3.   *Status of Claims:*

Claims 8-35 are withdrawn.

Claims 1-7 are pending.

Specification

4.   The <u>disclosure remains objected</u> to under 37 CFR 1.71, as being so

incomprehensible as to preclude a reasonable search of the prior art by the examiner.

For example, the following items are not understood: Entire specification is not clearly

written because it is translation of foreign application where the translated materials

does not enables the Examiner to understand the scope of invention and claims steps

clearly.

In order to speed the prosecution of the application, applicant is required to submit

amendment/claims which clarifies the scope of the disclosure so that the examiner

should be able to understand the scope of the invention (settlement apparatus) without

any effort clearly. The latest amendment is copy of verbiage from the specification

which is not clear in first place (see previous office action objection of disclosure).

Applicant should provide paragraph numbers/page numbers that supports the claimed

language. The examiner rejection is based on his best and broadest interpretation of the

claimed limitations. Applicant is welcome for interview to explain his invention clearly.

Applicant should be careful not to introduce any new matter into the disclosure (i.e.,

matter which is not supported by the disclosure as originally filed).

The Examiner has attempted to understand the specification and figure 2 and

has provided the following rejection with best of his understanding of the invention as

claimed.

Claim Rejections - 35 USC § 103

5.   The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all

obviousness rejections set forth in this Office action:

> (a) A patent may not be obtained though the invention is not identically disclosed or described as
> set forth in section 102 of this title, if the differences between the subject matter sought to be
> patented and the prior art are such that the subject matter as a whole would have been obvious
> at the time the invention was made to a person having ordinary skill in the art to which said
> subject matter pertains. Patentability shall not be negatived by the manner in which the invention
> was made.

Claims 1-7 are remain under 35 U.S.C. 103(a) as being unpatentable over Postrel (US

20070130011) in view of Laurent et al. (Laurent - US 7,206,769) and O'Leary et al.

(hereinafter O'Leary - US 6,609,113).

Re. Claim 1, Postrel discloses memory for storing (server inherent memory) first point

data, wherein the first data is representative of points given to a first user; and a

processor, wherein said processor;

obtains, from any of said terminals, transferor specification data that specifies a

first user, transferee specification data that specifies a second user, and transfer

amount data representing points to be transferred to an account associated with said

second user from said first user [read entire document particularly - Abstract; Figure 5;

paragraphs 02, 04, 12, 16, 27-33, 36-38, 55; claim 1 - see (holding, increasing or

decreasing a user's earned rewards and transfer points; exchange accounts stored in

memory)];

updates [paragraph 37] the first point data of said first user in such a way that

first points specified by said first point data are reduced by points designated

(credit/debit of accounts) by said obtained transfer amount data [02, 04, 12, 16, 27-33,

55; claim 1 – see credit and debit];

transmits said generated validation data to a supply source terminal of said

transferor specification data;

and When receiving said validation data from one of said terminals, modifies or

deletes said invalidation data, enabling said points by said second points associated

with said invalidation data and stores second point data [02, 04, 12, 16, 27-43, 55; claim

1 – see credit and debit; authorization].

Postrel *does not explicitly disclose* generates a second point data representing

an amount points given to said second user; generates invalidation data representative

of an amount of point within the account associated with the second user for prohibiting

said second user from using the points specified second point data; invalidation data

onto said memory; and generates validation data for validating the points specified by the second point data associated with said invalidation data.

However, Laurent discloses generates validation data for validating the points specified by the second point data associated with said invalidation data [Abstract; col. 5 line 63 through col. 6 line 2; col. 10 lines 1-62; col. 7 lines 57-63; claims]. It would have been obvious at the time the invention was made to a person having ordinary skill in the art to modify the disclosure of Postrel, as disclosed by Laurent, and include above steps to avoid double usage and fraud.

Further, O'Leary discloses generates a second point data representing an amount points given to said second user;

generates invalidation data representative of an amount of point within the account associated with the second user for prohibiting said second user from using, the usage of the points specified second point data; invalidation data onto said memory [see entire document particularly, Figures 9-10; col. 1 lines 5-61; col. 3 lines 38-56; col. 5 line 40 to col. 6 line 60, col. 14, col. 17 line 64 to col. 18 line 20]. It would have been obvious at the time the invention was made to a person having ordinary skill in the art to modify the disclosure of Postrel and Laurent and include transferring funds, electronic fund transfer and features disclosed by O'Leary to enable users to shop online using their personal computer, PDA (personal digital assistance) by charging the shopping amount (money) to their credit card or debit card accounts.

Re. Claims 2-7, Postrel discloses wherein said processor generates an inquiry data and stores, in association with each other, said inquiry data said second point data, said invalidation data, said first user, and said second user, onto said memory; and when said inquiry data is supplied to said process, supplies at least one of said second point data, said invalidation data, said data representing said first user and said data representing said second data, associated with said inquiry data, to the supply source of the corresponding inquiry data;

wherein when said inquiry data and cancellation data representing the cancellation of the transfer of points shown by said second point data are supplied to said processor, said processor changes or deletes said invalidation data associated with said inquiry data in response to said cancellation data, and updates said first point data in such a way that the points given to the first user specified by said transferor specification data are increased within the range of the amount corresponding to the points shown by said second point data, whereby canceling the transfer of the corresponding points; wherein said transferee specification data represents an e-mail address for said second user; wherein said second point is stored on said memory with second identification data that identifies said second user, said transfer notification data includes said second identification data, said processor prohibiting said second user the usage of the second point data associated with said second identification data regardless of whether or not said validation data is supplied to said processor until said processor is supplied with said second identification data; and wherein when said second identification data and transferee cancellation data representing the cancellation of reception of points shown

by said second point data are supplied to said processor, said processor changes or

deletes said invalidation data in response to the corresponding transferee cancellation

data and updates said first point data in such a way that the points given to the first user

specified by said transferor specification data are increased within the range of the

amount corresponding to the points shown by said second point data, thereby canceling

the transfer of the corresponding points;

wherein said processor generates data representing a web page for allowing said

second user to confirm the transfers of the points, and outputs said data representing

the corresponding web page to any one of said terminal supplying an URL (Uniform

Resource Locator) specifying the corresponding web page, said transfer notification

data includes URL that specifies said web page, and said processor prohibits said

second user to use the second point data associated with said identification data

regardless of whether or not said validation data is supplied to said processor until the

data representing said web page is output [Abstract; paragraphs 02, 04, 12, 16, 27-33,

55; claim 1]. Postrel *does not explicitly disclose* and said processor sends to said e-mail

address, an e-mail with transfer notification data showing that said second user receives

the transfer of points. However, this step is will-known where settlement is notified to the

transferor and transferee using statement and current banks are using email

notifications. Further O'Leary discloses email notification. It would have been obvious at

the time the invention was made to a person having ordinary skill in the art to modify the

disclosures of Postrel and Laurent and include transmits e-mail including transfer

notification data representing that said second user receives the transfer of points with

respect to the e-mail address shown by said transferee specification data to notify

transferor and transferee using paperless technology via internet.

Response to Arguments

6.   Applicant's arguments filed 3/16/2009 have been fully considered but they are

not persuasive. The arguments are responded in response to claims.

 SN 09/982644

        In response to Applicant's argument (page 21) that "for any instances in which

the Examiner took Official Notice in Office Action ..." The examiner already has

provided a prior art such as O'Leary (see entire document particularly description of

Figures 2 and 6) which discloses the concept of the sending confirmation e-mail to

sender. The Applicant has not provided any evidence that the examiner has made an

error taking an official notice (see MPEP 2144.03).

        In response to Applicant's argument (page 22) that "To establish prima facie ..."

and (page 23) "As noted above, independent claim 1 includes a processor that

generates ..." 1). The test for obviousness is not whether the features of a secondary

reference may be bodily incorporated into the structure of the primary reference; nor is it

that the claimed invention must be expressly suggested in any one or all of the

references. Rather, the test is what the combined teachings of the references would

have suggested to those of ordinary skill in the art. See *In re Keller*, 642 F.2d 413, 208

USPQ 871 (CCPA 1981) and 2). The examiner recognizes that obviousness can only

be established by combining or modifying the teachings of the prior art to produce the

claimed invention where there is some teaching, suggestion, or motivation to do so

found either in the references themselves or in the knowledge generally available to one

of ordinary skill in the art. See *In re Fine*, 837 F.2d 1071, 5 USPQ2d 1596 (Fed. Cir.

1988) and *In re Jones*, 958 F.2d 347, 21 USPQ2d 1941 (Fed. Cir. 1992). In this case

transferring funds electronically, avoiding double usage, preventing fraud (see pages 5-

6 of paper number 20080911).

In response to applicant's argument that the references fail to show certain

features of applicant's invention, it is noted that the features upon which applicant relies

(i.e., Claim 1 (recitation "includes a processor that generates a second point data") are

not recited in the rejected claim(s). Although the claims are interpreted in light of the

specification, limitations from the specification are not read into the claims. See *In re*

Van Geuns, 988 F.2d 1181, 26 USPQ2d 1057 (Fed. Cir. 1993).

In response to applicant's argument that "Laurent is directed ...", the fact

that applicant has recognized another advantage which would flow naturally from

following the suggestion of the prior art cannot be the basis for patentability when the

differences would otherwise be obvious. See *Ex parte Obiaya*, 227 USPQ 58, 60 (Bd.

Pat. App. & Inter. 1985) and argument that Laurent is nonanalogous art, it has been

held that a prior art reference must either be in the field of applicant's endeavor or, if

not, then be reasonably pertinent to the particular problem with which the applicant was concerned, in order to be relied upon as a basis for rejection of the claimed invention. See *In re Oetiker*, 977 F.2d 1443, 24 USPQ2d 1443 (Fed. Cir. 1992). In this case, Laurent discloses a known element or limitation electronic fund transfer (tokens) using electronic wallet system server (processor is inherent) [Figure 2; col. 2 lines 26-40, col. 5 lines 63-66] which prevents double spending by invalidating [col. 10 line through col. 12 line 9 - "Debited token will be newly created" ... "in case of transmission problems or if the server ... credited again" ..."If the completion code indicates no error ... corresponding to the debited purse, and in the other cases, the purse is credited again." "For this purpose, according to ... for each registered purse, there exist two transaction identifiers which are used in this ... to show the validity of exchange messages." and claim 1 see two stages.] It is obvious that when debiting an amount from one account, temporary store the transaction and crediting the amount to second account, the debiting action inherently subtracts the amount (generates invalid data in one side of ledger) for the first account (amount can not be used) and deposit the amount to the second account (generates a valid data - amount receipt on the other side of the ledger) by add the amount to the second account. See In re KSR for combing known elements to yield predicable.

Conclusion

7.   **THIS ACTION IS MADE FINAL.** Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE

MONTHS from the mailing date of this action. In the event a first reply is filed within

TWO MONTHS of the mailing date of this final action and the advisory action is not

mailed until after the end of the THREE-MONTH shortened statutory period, then the

shortened statutory period will expire on the date the advisory action is mailed, and any

extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of

the advisory action. In no event, however, will the statutory period for reply expire later

than SIX MONTHS from the mailing date of this final action.

Any inquiry concerning this communication or earlier communications from the

examiner should be directed to HARISH T. DASS whose telephone number is

(571)272-6793. The examiner can normally be reached on 8:00 AM to 4:50 PM.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's

supervisor, Abdi Kambiz can be reached on 571-272-6702. The fax phone number for

the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the

Patent Application Information Retrieval (PAIR) system. Status information for

published applications may be obtained from either Private PAIR or Public PAIR.

Status information for unpublished applications is available through Private PAIR only.

For more information about the PAIR system, see http://pair-direct.uspto.gov. Should

you have questions on access to the Private PAIR system, contact the Electronic

Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a

USPTO Customer Service Representative or access to the automated information

system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

/Harish T Dass/
Primary Examiner, Art Unit 3692

6/7/2009